



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,737	07/09/2001	Edouard G. Lebel	S-21043B	1621
22847	7590	11/19/2003	EXAMINER	
SYNGENTA BIOTECHNOLOGY, INC.			KUBELIK, ANNE R	
PATENT DEPARTMENT			ART UNIT	
3054 CORNWALLIS ROAD			PAPER NUMBER	
P.O. BOX 12257			1638	
RESEARCH TRIANGLE PARK, NC 27709-2257			DATE MAILED: 11/19/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/901,737

Applicant(s)

LEBEL ET AL.

Examiner

Anne R. Kubelik

Art Unit

1638

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 25 September 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 6-9, 12-23 and 30.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☒ The proposed drawing correction filed on 7/11/01 is a) ☐ approved or b) ☒ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Continuation of 3. Applicant's reply has overcome the following rejection(s):  
102 over Yoshikawa et al, Borriess et al, Ryals et al. 103 over Yoshikawa et al.

Continuation of 5. does NOT place the application in condition for allowance because:

112, 1st written description: Applicant urges that law requires that a representative number of nucleic acids encoding cellulases be described, not all cellulases. Applicant urges that their description of T fusca E1, E2 and E5 genes and Collmer's reference to two papers that teach cellulases from two other bacteria satisfies the written description requirement. Applicant also states that a number of other genes are taught in the specification in Yoo et al, Thomas et al, and that exemplary cellulases include but are not limited to endoglucanases, exoglucanases and beta-D-glucosidases from bacteria and fungi. This not found persuasive. The claims are broadly drawn to a plant comprising a nucleic acid encoding any cellulase. Neither the specification nor the prior art describe the sequence of genes encoding endocellulases, exocellulases or cellobioses to the full breadth of the claims.

112, 1st, enablement: Applicant urges that the cited references teaches cellulases from a number of sources. Applicant also urges that ample guidance is provided for construction of transformation vectors, and for plant transformation. This not found persuasive. The claims are broadly drawn to a plant comprising a nucleic acid encoding any cellulase. Neither the specification nor the prior art teach the sequence of genes encoding endocellulases, exocellulases or cellobioses to the full breadth of the claims.

103 over Bennett et al: Applicant urges that the recited text refers to beta-1,4- endoglucanases, not beta-1,3 endoglucanases. Applicant also urges that two of the inventors of Bennett et al are authors of the later published Lashbrook reference which teaches that their endo-beta-1,4-glucanase is not a cellulase. This is not found persuasive because the instant specification teaches that endo-beta-1,4-glucanases are cellulases.

Objection to claim 16: the recitation of "derives" is actually in claim 13. The objection is withdrawn for claim 16.



AMY J. NELSON, PH.D.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

AMY J. NELSON, PH.D.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600